

Remarks

This paper is submitted in response to the outstanding office action mailed July 24, 2009, providing a three month statutory period for reply. A petition for extension of time under 37 CFR 1.136 of two (2) months is submitted along with this paper, with instructions for the USPTO to deduct from the Applicant Monsanto's USPTO Deposit Account No. 13-4125 the appropriate fee for such petition under 37 CFR 1.17(a)(2). Thus it is believed that this paper is timely filed.

The Official Action indicated that the Applicants [provisional] election of Group XI, claims 8-9 and 12-13 to the extent that these claims read on SEQ ID NO:4, with traverse, was acknowledged but was found unpersuasive and therefore made final. The Applicant reserves the right to appeal to the Director the finality of the restriction requirement (37 CFR 1.144). In making the requirement final, the Examiner has withdrawn all of the original 20 claims except claims 8-9 and 12-13. With this paper, claims 1-7, 9-16, and 19-20 are cancelled, claims 8, and 17-18 are amended, claims 17-18 are withdrawn subject to rejoinder upon allowance of the base claim(s), and new claims 21-28 are added. It is believed that the claims amendments and new claims are fully supported by the specification as filed and no new matter has been added. It is respectfully requested that the new claims and the amendments be entered and that the Examiner consider the claims, in view of the remarks herein, as being in condition for allowance.

Bibliography in the Specification

The Applicant wishes to thank the Examiner for pointing out that the references in the bibliographical section in the specification have not been considered because these have not been submitted in an IDS. To the extent that the Applicant desires to have these references considered, these will be submitted in an IDS.

Claims Rejections - 35 USC 112, 1<sup>st</sup> Paragraph

The Examiner has rejected claim 9 under 35 USC 112, first paragraph. It is believed that this rejection has been obviated with the cancellation of claim 9. It is respectfully requested that the Examiner remove this grounds of rejection.

Claims Rejections - 35 USC 112, 2<sup>nd</sup> Paragraph

The Examiner has rejected claim 9 under 35 USC 112, second paragraph. It is believed that this rejection has been obviated with the cancellation of claim 9. It is respectfully requested that the Examiner remove this grounds of rejection.

### Claims Rejections - 35 USC 102

The Examiner has rejected claims 8-9 under 35 USC 102(e) as being anticipated by Carozzi et al. (US Patent Serial No. 7,355,099, filed February 2003). This rejection is traversed.

The Examiner asserts that the '099 patent was filed Feb 2003, but in fact, the provisional application to which the '099 patent claims priority was filed in Feb 2003. The provisional application serial No. 60/448,810, filed February 20, 2003, discloses a single nucleotide sequence encoding a single amino acid sequence that is not the same as the sequence of the amino acid that is set forth in SEQ ID NO:5 of the '099 patent. This SEQ ID NO:5 selected by the Examiner was first disclosed in the '099 patent specification upon the filing date of the application from which the '099 patent was issued (US Patent Application Serial No. 10/782,020 filed Feb 19, 2004). This filing date is *after* the filing date of the priority application to which the instant application claims priority, therefore Carozzi et al. would appear to be an improper 35 USC 102(e) reference. Furthermore, SEQ ID NO:5 would also not be a proper 102(e) art reference over the instantly claimed subject matter because the sequence as set forth at SEQ ID NO:5 of the '099 patent is not the same as the sequence set forth in the amino acid sequence of SEQ ID NO:4 of the claimed subject matter.

Therefore, it is respectfully requested that the Examiner remove this grounds of rejection.

### Claims Rejections - 35 USC 103

The Examiner has rejected claims 8-9 and 12-13 under 35 USC 103(a) as being unpatentable over Carozzi et al (the '099 patent referenced above). The Examiner incorrectly asserts that these rejected claims are drawn to a method of controlling lepidopteran pests with a protein of SEQ ID NO:4. Only claims 12-13 are drawn to methods for controlling lepidopteran pests with proteins comprising the amino acid sequence as set forth in SEQ ID NO:4. Thus, it is believed that the rejection should be properly limited to claims 12-13, if at all.

The Examiner admits that the claimed protein set forth in SEQ ID NO:4 is not taught by Carozzi et al.

Reviewing the rebuttal above under the heading of 102(e), it is re-established that the Carozzi et al reference was not a proper 102(e) reference since Carozzi et al did not disclose a protein prior to the priority date of the instant application that resembled the amino acid sequence at SEQ ID NO:4. Carozzi et al ('099) was only available *after* the priority date of the instant specification was filed. Therefore, Carozzi et al. is not a proper reference for use as a 103(a) rejection. Therefore, it is respectfully requested that the Examiner remove this grounds of rejection.

Respectfully submitted,

December 18, 2009

/ Timothy K. Ball /

Date: \_\_\_\_\_

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